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08/556,038

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/556,038	11/09/95	BOUSSIOTIS	V RPI-022CP

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EXAMINER

GAMBEL, P
ART UNIT PAPER NUMBER

1806 5

DATE MAILED: 03/14/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 DAYS month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-47 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-47 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-11, drawn to methods for stimulating proliferation by a T cell which expresses a cytokine receptor gamma chain using an agent that binds to the cytokine receptor gamma chain, classified, for example, in Class 424, subclasses 144.1 and 85.2.

II. Claims 11-18, drawn to methods for stimulating proliferation by a T cell which expresses a cytokine receptor gamma chain using an agent that acts intracellularly to stimulate phosphorylation of JAK kinase, classified, for example, in Class 514, subclass 44

III. Claims 19-44, drawn to methods for inducing unresponsiveness to an antigen in a T cells which expresses a cytokine receptor gamma chain, classified, for example, in Class 424, subclass 144.1 and 145.1.

IV. Claims 45-47, drawn to methods for identifying an agent inhibits delivery of a signal through a cytokine receptor gamma chain, classified, for example, in Class 435, subclass 4.

2. The inventions are distinct, each from the other because of the following reasons:

The methods of Groups I-IV differ in the method objectives, method steps and parameters and in the reagents used. Group I contains claims drawn to methods for stimulating proliferation by a T cell which expresses a cytokine receptor gamma chain using an agent that binds to the cytokine receptor gamma chain. Group II contains claims drawn to methods for stimulating proliferation by a T cell which expresses a cytokine receptor gamma chain using an agent that acts intracellularly to stimulate phosphorylation of JAK kinase. Group III contains drawn to methods for inducing unresponsiveness to an antigen in a T cells which expresses a cytokine receptor gamma chain. Group IV contains claims drawn to methods for identifying an agent inhibits delivery of a signal through a cytokine receptor gamma chain. These methods are clearly distinct.

3. Upon the election of Group I, a further election of species is required:

This application contains claims directed to the following patentably distinct species of the claimed invention:

- I) Methods for stimulating proliferation by a T cell which expresses a cytokine receptor gamma chain using a cytokine;
- II) Methods for stimulating proliferation by a T cell which expresses a cytokine receptor gamma chain using an anti-gamma chain antibody.

The methods of species I and II differ in the method objectives, method steps and parameters and in the immunological reagents used. The examination of species I and II would require different searches in the U.S. Patent shoes and in the scientific literature and would involve the consideration of separate issues in determining patentability.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 4-10 are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

5. Upon the election of Group III a further election of species is required as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention:

- I) methods for inducing unresponsiveness to an antigen in a T cells which expresses a cytokine receptor gamma chain using an agent that acts extracellularly to inhibit delivery of a signal through a cytokine gamma chain;
- II) methods for inducing unresponsiveness to an antigen in a T cells which expresses a cytokine receptor gamma chain using an agent that acts intracellularly to inhibit delivery of a signal through a cytokine gamma chain.

The methods of species I and II differ in the method steps and parameters and in the reagents used.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 19 is generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

7. Upon the election of species I above, a further election of species is required: among methods using an agent which is
- i) an anti-gamma chain antibody
 - ii) an anti-IL-7 antibody;
 - iii) an anti-IL-4 antibody and
 - iv) an anti-IL-2 antibody.

The methods of species i-iv in the method parameters and in the immunological reagents used. The examination of species i-iv would require different searches in the scientific literature and would involve the consideration of separate issues in determining patentability.

8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

10. Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-4242 or (703) 305-7939.

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Art Unit 1806

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee can be reached on (703) 308-2731. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1800 receptionist whose telephone number is (703) 308-0196.

Phillip Gambel, Ph.D.
Patent Examiner
Group 1800
March 12, 1997

A handwritten signature in cursive script that reads "Phillip Gambel". The signature is written in dark ink and is positioned below the typed name and title.